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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,805	11/06/2001	Shun Ueki	4034-4	4351
23117	7590	04/21/2004	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			DUONG, TAI V	
			ART UNIT	PAPER NUMBER
			2871	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/985,805

Applicant(s)

UEKI ET AL.

Examiner

Tai Duong

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*Handwritten initials*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

Upon reconsideration and in view of Applicant's remarks regarding the listing of claims, a new election/restriction is required.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-43, drawn to a reflective display device, classified in class 349, subclass 113.
- II. Claims 44-48, drawn to a prism array sheet, classified in class 359, subclass 640.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claim 1 is the evidence claim showing the reflective display device does not need the particulars of the prism array sheet of claim 44 for patentability. The subcombination has separate utility such as an element of an illuminating device for directing light from a light source into desired direction, instead of in a *reflective* display device. In addition, the prism array sheet can be used in a *transmissive* display device.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and vice versa, restriction for examination purposes as indicated is proper.

Further, Group I contains claims directed to the following patentably distinct species of the claimed invention:

A: the species of Embodiment 1.

Species A contains claims directed to the following patentably distinct sub-species:

A1: claims 5 and 6 drawn to a reflective display device of Figs. 4-6.

A2: claim 11 drawn to a reflective display device of Fig. 10C.

A3: claim 12 drawn to a reflective display device of Fig. 10B.

A4: claim 13 drawn to a reflective display device wherein said plurality of other faces of said optical element are rough faces.

A5: claims 17-21 drawn to a reflective display device of Figs. 11A-11C.

B: claim 24 drawn to the species of Embodiment 2 (Fig. 12).

C: claims 40-42 drawn to the species of Embodiment 3 (Fig. 13).

D: claims 27-30 and 48 drawn to the species of Embodiment 4 (Figs. 14 and 18).

E: claim 25 drawn the species of Embodiment 7 wherein the optical element is made of a material having a variable refractive index  $n_1$ .

F: claims 31 and 32 drawn to the species of Embodiment 8 (Fig. 19).

G: claims 33 and 34 drawn to the species of Embodiment 9 (Figs. 20-22).

H: claim 43 drawn to the species of Embodiment 10 (Fig. 23).

If Group I is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (B-H) or sub-species (A1-A5) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, claims 1, 2, 4, 7-10, 22 and 23 are generic with respect to Species A and C while claims 1, 2, 4, 7-10 and 23 are generic with respect to Species D. Claims 26, 38 and 39 are also generic with respect to Species C and D. Claims 1, 2, 4 and 7-9 are generic with respect to Species B. Claims 1, 2, 4 and 7-10 are generic with respect to Species E and F while claims 1, 3, 4 and 7-10 are generic with respect to Species G and H.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication should be directed to Tai Duong at telephone number (571) 272-2291.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

  
TVD

04/04

  
TOANTON  
PRIMARY EXAMINER